

## Remarks

### The Priority Date

The confusion with regard to the claim for priority is regretted. Applicant has amended the first sentence concerning the relation back to assert priority back to the 1987 design patent application. Accordingly, one basis raised by the Examiner has been overcome, namely, that the applicant did not properly claim the benefit of the earlier filing date.

The second issue concerning the benefit of the earlier filing date concerns the date of abandonment after 1987 application, which the examiner reports is "4/3/1990." However, our records indicate that Serial No. 516,473 was filed on April 30, 1990, and that this occurred concomitantly with abandonment of the 1987 application.

Applicant suggests that there is a typographic error in the Office Action or that the records of the PTO are in error with regard to the date of abandonment of the 1987 design application.

First, attached hereto as Exhibit 1 is a copy of the cover page of Tracy U.S. Patent 5,064,421 issued November 12, 1991. In the field of "related U.S. application data," it is seen clearly that the PTO has already acknowledged that Serial No. 516,473 is a continuation-in-part of Serial No. 93,681<sup>07/0</sup> filed on September 8, 1987. This means there was co-pendency.

Attached as Exhibit 2 is a copy of the Petition for Extension of Time to file an Appeal Brief in the 1987 application. As can plainly be seen, Applicant's prior attorney, Edward Gilhooly, was simultaneously filing a continuation-in-part application. That application was mailed on April 30, 1990 as attested to by the Certificate of Mailing. Also enclosed as part of Exhibit 2 is the Certificate of Mailing by Express Mail signed by attorney Gilhooly certifying that the new application was mailed on April 30, 1990. That 1987 application, for which an appeal brief was due, was to be abandoned

upon the filing of the new application. The PTO received the petition for an extension of time of two months up until May 1, 1990, and received the petition fee.

Inasmuch as (1) the continuation-in-part was granted a filing date of April 30, 1990, and (2) upon the instruction of the attorney of record, Mr. Gilhooly, the PTO was authorized to abandon the 1987 design patent application upon the filing and granting a serial number of the 1990 application, it is clear that the 1990 application, namely Serial No. 07/516,473, was co-extensive or co-pending with the 1987 design patent application. Thus, the design patent application was not abandoned until April 30, 1990 at the earliest. The examiner should bear in mind that the applicant had paid an extension fee to extend the time for filing her appeal brief up to May 1, 1990.

Accordingly, to the extent that the Office Action herein reports that the design application was abandoned on "4/3/1990," it appears to be a typographic error, and that date should actually be 4/30/1990. Consequently, in view of the present amendment, the applicant is entitled to claim the benefit of the 1987 filing date.

### **Foreman**

With regard to the rejection stated in ¶8 over Foreman, U.S. Patent 4, 816,025, applicant has sworn behind that date. The examiner is reminded that the amendment mailed January 29, 1999 and received by the PTO on or about February 1, 1999 (Amendment B) included a declaration of the inventor swearing behind the reference. Additionally, Amendment B not only swore behind the reference, but also distinguished thereover. Reliance by the examiner on Foreman as a reference, whether under §102 or §103, is improper. For this reason, the anticipation rejection of ¶8 must be withdrawn.

For the same reason, the stated obviousness rejection given in ¶10 of the Office Action cannot be maintained. Foreman is unavailable as a prior art reference and therefore cannot be used in combination with any secondary reference to support any rejection. The examiner does not contend that the secondary reference, Lindquist U.S. Patent 3,572,342, itself discloses the invention.

### **McConnell**

The rejection of claims 7-10 as anticipated or obvious over by McConnell, 3,461,872 is distressing. Applicant distinguished over McConnell in one or more of the parent prosecutions and indeed, this was one of the references which the PTO Board of Patent Interferences and Appeals considered in Appeal No. 95-3512. It is unclear why the examiner is raising art that the BPAI has already looked at and determined not to invalidate or support the rejection of the claim pending at that time. Attached as Exhibit 3 is a copy of the BPAI decision.

Upon perusal of that decision, the examiner will see that the presently pending claims have the same feature that the Board found persuasive over McConnell. The decision in the appeal focused on claim 26 as the representative claim. Claim 26 recited "a soft padding member located along at least one of said waistband portions, being adjacent to said plastic layer edge, the soft padding member being distinct from all of said body-portion layer, the soft padding member including a material formed from a soft substance presenting a soft surface along at least a portion of said inside of the diaper waistband portion despite said plastic layer edge." The examiner will appreciate that these limitations, with very slight modification, are present in claim 7 now being rejected over the same reference. The same limitations that led the board to reverse the rejection over McConnell with other art apply fully in the present case. The Examiner should immediately withdraw the

rejection based on McConnell on the basis of the decision already made by the BPAI in the parent application.

### **Other Rejections**

The rejection under §112 complains about the term “soft.” However, that word is used in the same claims which the Board of Appeals already approved and already patented. Withdrawal of this rejection is requested.

The rejection under §101 appears to turn on the issue stated in ¶14 of the Office Action, namely, that the person who signed the disclaimer (allegedly) has not stated the extent of his or her interest in the application or patent.

This is respectfully traversed. The very first paragraph of the document states as follows: “I, Edward D. Manzo, represent that I am the attorney of record for this application and U.S. Patent No. 5,064,421. Rhonda Tracy is the inventor and owner of both the application and the patent.” From this, it is stated expressly that the person who signed the Terminal Disclaimer is the attorney of record. The next sentence indicates that the owner is the inventor, Rhonda Tracy. What further statement is the examiner looking for? The undersigned is certainly willing to file a supplemental document or another terminal disclaimer indicating that he (the attorney) does not own any portion of the patent or the patent application, but that he is simply the attorney of record, and that the inventor Rhonda Tracy is the owner of 100% of the application.

Turning now to ¶15 and 16 of the Office Action, the apparent reason that the inventor’s declaration has not been deemed effective to overcome Foreman as a reference is that the examiner

deems Foreman to be a statutory bar under 102(b) which could not be overcome by an affidavit or declaration. However, as explained herein, it is now clear that the present application properly traces its roots back to earlier than the March 28, 1989 issue date of Foreman, which therefore cannot be a 102(b) bar.

The comments by the examiner concerning attacking references individually seem to be moot in view of the fact that Foreman is unavailable as a reference, and therefore there is no combination that needs to be discussed.

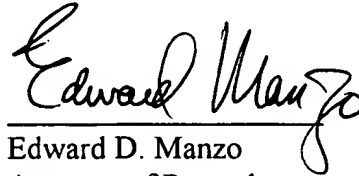
### **Conclusion**

Applicant requests that the examiner should indicate that Foreman is no longer available as a reference, withdraw all rejections based wholly or partly on Foreman as a reference, withdraw any and all rejections based on McConnell (which was already fully considered by the PTO Board of Patent Appeals and Interferences), withdraw the rejection based on using the word "soft" which has already passed muster by the BPAI, accept the terminal disclaimer, and pass this application to issuance without further delay.

The undersigned respectfully requests a telephone conference with the examiner in the event

that any issues impede the prompt and early allowance of the present application.

Respectfully submitted,

A handwritten signature in cursive script, reading "Edward D. Manzo". The signature is written in dark ink and is positioned above a horizontal line.

Edward D. Manzo  
Attorney of Record  
Registration No. 28,139

Dated: October 21, 1999

Cook, Alex, McFarron, Manzo,  
Cummings & Mehler, Ltd.  
200 West Adams Street, Suite 2850  
Chicago, IL 60606  
312-236-8500

Enclosed: Exhibit 1 - a copy of the cover page of the Tracy U.S. Patent 5,064,421 issued November 12, 1991

Exhibit 2 - a copy of the Petition for Extension of Time to File an Appeal Brief in the 1987 application and Certificate of Mailing by Express Mail

Exhibit 3 - a copy of the BPAI decision